



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,416	06/15/2007	Christian Saclier	33597-US-PCT	8348

74550 7590 05/13/2009

FRANK A. SMITH
Novartis Consumer Health, Inc.
200 Kimball Drive
OTC PATENT DEPARTMENT - 5TH FLOOR
Parsippany, NJ 07054-0622

EXAMINER

LALLI, MELISSA LYNN

ART UNIT	PAPER NUMBER
----------	--------------

3728

MAIL DATE	DELIVERY MODE
-----------	---------------

05/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,416	Applicant(s) SACLIER ET AL.	
	Examiner MELISSA L. LALLI	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment submitted October 23, 2009 has been acknowledged. Amended claims 2-7, cancelled claim 1, and newly added claim 8 are entered. Therefore, claims 2-8 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-8 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations "the case" and "the bottom" are stated on line 6 of claim 8. There is no antecedent basis for these limitations in the claim. It seems that "case" should be replaced by "casing" to ensure consistency in the claim language. Appropriate correction is required.

Regarding claim 2, "the abutment" as stated on line 3 should read "the at least one abutment" as previously mentioned on line 2. This will ensure consistency of the claim language. Additionally, the limitations "the first cavity" and "the end of the blister package" are stated on line 5. There is no antecedent basis for these limitations in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3728

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-4, 7, and 8 are finally rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,109,984 to Romick (Romick ('984)).

Regarding claim 8, Romick ('984) discloses a casing (10) for a blister package (68) wherein the casing has a bottom part (14) and the bottom part has a plurality of openings (42). The bottom part has positioning means (16) shaped and arranged such that the positioning means are capable of positioning an asymmetric shaped blister package having cavities so that each cavity of the blister package is centered with one of the openings in a bottom of the bottom part of the casing irrespective of which possible way the blister package could be inserted in the bottom part of the casing (figs. 1-3). It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claims 2 and 4, Romick ('984) discloses the casing (10) having a cover (12) for closing the bottom part (14). The positioning means (16) are arranged at a longitudinal end of the bottom part and comprise at least one abutment (44) extending up to the nearest opening and a recess (50) formed to accommodate an end region of the blister package (68) extending between a first cavity (70) and the end of the blister package (fig. 3). Since the blister package and cavities are integrally formed, it can be said that the abutment abuts against a cavity.

Regarding claim 3, Romick ('984) discloses the bottom part (14) comprising retaining and guiding means (44) for holding the blister package down on the bottom ad for properly arranging the blister package (68) with regard to its lateral position (figs. 1 & 3).

Regarding claim 7, Romick ('984) the bottom part (14) having stepped engaging means (44) for supporting a blister package (68) after being properly arranged on the bottom part and arranged at the end of the bottom part opposite the positioning means (fig. 2).

6. Claims 3, 7, and 8 are finally rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,489,025 to Romick (Romick ('025)).

Regarding claim 8, Romick ('025) discloses a casing (200) for a blister package (100) wherein the casing has a bottom part (210) and the bottom part has a plurality of openings (212). The bottom part has positioning means (202) shaped and arranged such that the positioning means are capable of positioning an asymmetric shaped blister package having cavities so that each cavity of the blister package is centered with one of the openings in a bottom of the bottom part of the casing irrespective of which possible way the blister package could be inserted in the bottom part of the casing (figs. 1-3). It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claim 3, Romick ('025) discloses the bottom part (210) comprising retaining and guiding means (216) for holding the blister package (100) down on the bottom ad for properly arranging the blister package with regard to its lateral position (figs. 1-3 and col. 4, lines 43-47).

Regarding claim 7, Romick ('025) discloses the bottom part (210) having stepped engaging means (216) arranged at the opposite end of the positioning means for supporting the blister package on the bottom part (col. 4, lines 43-47).

7. Claims 3, 4, 7, and 8 are finally rejected under 35 U.S.C. 102(b) as being anticipated by French Patent Document No. 2,845,668 to Gattefosse et al. (Gattefosse).

Regarding claim 8, Gattefosse discloses a casing (10) for a blister package (12) wherein the casing has a bottom part (20) and the bottom part has a plurality of openings (42). The bottom part has positioning means (32) shaped and arranged such that the positioning means are capable of positioning an asymmetric shaped blister package having cavities so that each cavity of the blister package is centered with one of the openings in a bottom (21) of the bottom part of the casing irrespective of which possible way the blister package could be inserted in the bottom part of the casing (figs. 1, 2, & 7). It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claims 3, 4, and 7, Gattefosse discloses the bottom part (20) having retaining and guiding means (48) for holding the blister package (12) down on the bottom (21) and for properly arranging the blister package on the bottom with regard to

Art Unit: 3728

its lateral position (fig. 4, 48 interlocks with mating portion 46 to hold down the blister package). The casing (10) has a cover (60) for closing the bottom part (fig. 6).

Additionally, Gattefosse discloses the bottom part having stepped engaging means (fig. 3, 48F) arranged at the opposite end of the positioning means (32) for supporting the blister package on the bottom part.

8. Claims 2-4, 7, and 8 are finally rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,817,819 to Kelly.

Regarding claim 8, Kelly discloses a casing (10) for a blister package (37) wherein the casing has a bottom part (12) and the bottom part has a plurality of openings (20). The bottom part has positioning means (35 on wall 26 and col. 4, lines 8-11) shaped and arranged such that the positioning means are capable of positioning an asymmetric shaped blister package having cavities so that each cavity of the blister package is centered with one of the openings in a bottom (21) of the bottom part of the casing irrespective of which possible way the blister package could be inserted in the bottom part of the casing (figs. 5 & 7). It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding claims 2 and 4, Kelly discloses the casing (10) having a cover (11) for closing the bottom part (12). The positioning means (35 on wall 26) are arranged at a longitudinal end (26) of the bottom part and comprise at least one abutment (35) extending up to the nearest opening and a recess formed to accommodate an end

Art Unit: 3728

region of the blister package extending between a first cavity and an end of the blister package (fig. 8). Since the blister package and cavities are integrally formed, it can be said that the abutment abuts against a cavity.

Regarding claim 3, Kelly discloses the bottom part (12) having retaining and guiding means (35 on wall 28 or 33) for holding the blister package (37) down on the bottom (21) and for properly arranging the blister package on the bottom with regard to its lateral position (col. 4, lines 8-11).

Regarding claim 7, Kelly discloses the bottom part (12) having stepped engaging means (35 on wall 28) arranged at the opposite end of the positioning means (35 on wall 26) for supporting the blister package (37) on the bottom part.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5 and 6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Romick ('984), Gattefosse, and Kelly in view of US 6,789,677 to Maietta.

Regarding claims 5 and 6, none of the disclosures of Romick ('984), Gattefosse, or Kelly teaches the cover being pivotally attached to the bottom part so that the cover can be pivoted in a plane parallel to the bottom part; However, Maietta discloses a similar casing (10) for a blister package with a bottom part (20) and a sleeve-like cover (18) for closing the bottom part. The cover is pivotally attached to the bottom part by an

Art Unit: 3728

axle (46) allowing the cover to be pivoted in a plane parallel to the bottom part (fig. 2). It would have been obvious to one having ordinary skill in the art at the time of the invention to have substituted the sleeve-like, pivotal cover of Maietta for the cover of any of the casings of Romick ('984), Gattefosse, or Kelly in order to create a child-resistant locking feature to enclose the blister package as taught by Maietta (col. 1, lines 15-34).

Response to Arguments

11. Applicant's arguments with respect to claims 2-8 have been considered but are moot in view of the new ground(s) of rejection; however, the examiner would like to address applicant's arguments regarding the Romick ('984), Romick ('025), Gattefosse, and Kelly references.

In response to applicant's argument that none of the above stated references "disclose a device where the holes in the container would still line up with the holes in an asymmetrically shaped blister package having one end portion longer than the other if the blister package were turned around one-hundred eighty degrees and the opposite end was inserted into the device" as stated in applicant's "Remarks/Arguments", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The positioning means as pointed out in the rejections above for each of the references are capable of holding an asymmetrically shaped blister package so that each of the cavities of the blister

Art Unit: 3728

package is centered with one of the openings in the bottom of the bottom part of the casing irrespective of which way the blister package is inserted in the bottom part of the casing.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA L. LALLI whose telephone number is (571)270-5056. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM (EST).

Art Unit: 3728

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLL
4/27/09

/Mickey Yu/
Supervisory Patent Examiner, Art
Unit 3728